

Serial No. 09/738,984
Reply to Office Action of August 27, 2003

Docket No. P-0164

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks. Claims 1-25 are pending in the application.

Specification Informalities

The specification was objected to because of informalities. This Amendment addresses this objection by correcting the noted informalities in the specification. Accordingly, withdrawal of this objection is respectfully requested.

Claim Objections and 35 U.S.C. § 112 Rejections

Claim 1 was objected to because of informalities. Each of the informalities identified in the Office Action has been addressed in this Amendment. Applicant accordingly requests the Examiner to reconsider and withdrawal these objections.

Claims 4, 7, 12 and 17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter set forth therein. Each of the formalities identified in the Office Action has been addressed in this Amendment, and Applicant accordingly requests the Examiner to reconsider and withdraw this rejection.

Regarding the rejection to “an other protocol type field”, Applicant has amended these

claims to recite “a protocol type field”, which Applicant respectfully submits would be understood by one of ordinary skill in the art to refer to the protocol being used in the particular transmission, which can vary from system to system. Accordingly, the specific type of protocol does not have to be specified to define the scope of the invention or to render the claim definite.

The foregoing claim amendments to address the 35 U.S.C. § 112, second paragraph rejections and claim objections were made to correct formalities such grammatical errors and to place the present Application in better form for examination. Therefore, the foregoing amendments do not narrow the scope of the pending claims.

Allowable Subject Matter

Applicant notes with appreciation the indication on page 10 of the Office Action that claims 9, 14 and 19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicant submits this is not necessary in view of the following remarks.

35 U.S.C. § 102 & 103 Rejections

Claims 1-2, 10-13 and 15-17 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Meche et al. (U.S. Patent No. 5,600,708 “Meche”). Claims 3 and 16 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Meche as applied to claim 1 and 15 in view of Examiner’s Official Notice (EON). Claim 4 was rejected under 35 U.S.C. § 103(a) as

allegedly being unpatentable over Meche in view of Examiner's Official Notice (EON) as applied to claim 1 and 3 and in further view of Fascenda et al. (U.S. Patent No. 6,304,746 "Fascenda"). Claim 5-8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Meche as applied to claim 1 in view of Vaihoja et al. (U.S. Patent No. 5,835,858 "Vaihoja").

Applicant respectfully traverses each of these rejections for at least the following reasons.

Regarding claim 1, the Office Action alleges that Meche discloses all the features of Applicant's claimed combinations. Applicant respectfully disagrees with this assertion. For example, the Office Action alleges that Meche at column 5, lines 20-45 and column 6, lines 32-36 disclose "setting a phone-locked state for the lost terminal according to the transmitted order message for phone-locking", as recited in Applicant's claimed combinations. These sections of Meche are recited below with emphasis added.

(Column 5, lines 20-45)

FIG. 3 outlines the mobile equipment logic MT 10 associated with the invention. When a message is received from the MSC 20, the MT 10 must determine if the message received represents a command to activate one of the newly defined LOCKs step 100. First check preferred is identified in step 105 as the check to see if the message is a SECURITY REQUEST MESSAGE INDICATING **MT-UIM lock**. If the message contains such a command, control flow branches from 105 to step 120. If the message is not a **MT-UIM LOCK**, control flow branches from step 105 to step 110.

Mobile equipment MT 10 processing from steps 110 onwards will be discussed following the MSC 30 logic associated with **UIM-IMEI locking step 325** of FIG. 2.

In step 120 of FIG. 3 the MT 10 must verify that the message received is authorized. This is done by utilizing conventional authentication procedures in

the UIM 20 combined with new procedures in the MT 10 to execute the function. As noted in FIG. 5a, the **MT-UIM LOCK** message contains the RAND from the AuC 36, which is well known to one skilled in the art. In order to harden this procedure, the preferred embodiment of this invention will place additional requirement on the RAND to protect against hacking. These requirements should be well considered and specific to a particular implementation.

(Column 6, lines 32-36)

In step 142 the MT 10 has verified that it has **locked to the UIM 20** in question and therefore constructs a SECURITY RESPONSE (FIG. 5b) indicating the **MT-UIM LOCK** was successful. This message is transmitted to the MSC 30. Control flow falls to step 150 and the process is finished.

In contrast to the Office Action's allegations, Meche as clearly indicated above teaches only to lock the user identify module (UIM) to the mobile terminal (MT), which prevents reprogramming the MT with a new UIM. There is no mention in Meche of setting a phone-locked state (e.g., preventing phone calling and access to user information), as recited in Applicant's claim 1 and combinations thereof. In contrast, locking the UIM to the mobile terminal does not prevent use of the mobile terminal but only prevents the reprogramming of the phone or reuse of the UIM as expressly state in column 3, lines 5-22 of Meche.

As stated in MPEP § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Meche reference applied by the Office Action neither expressly nor inherently describes every

feature of Applicant's claimed combinations as detailed in the foregoing arguments. Therefore, Applicant respectfully submits that the applied reference does not anticipate Applicant's claimed combinations as alleged by the Office Action. Further, Applicant respectfully submits that the Fascenda and Vaihoja references as applied do not cure at least the above noted deficiencies.

The remaining independent claims (i.e., claims 10 and 15) recite related subject matter to the above-identified independent claim, and are therefore allowable for reasons similar to those given above.

The dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

For instance, regarding claim 5, “reading a stored password, setting a phone-locked state and re-booting the terminal, in case that the received order message is a message for phone-locking”, is not taught or suggested by Meche or in combination with Vaihoja. In contrast to the Office Action’s allegations, Meche does not teach reading a stored password, but instead teaches to use a random function to prevent hackers from accessing the system to reprogram the UIM of the mobile terminal.

Regarding the combination with Vaihoja, Applicant respectfully submits that Vaihoja discloses powering off and rebooting the phone to access the network services, which is in direct contradiction to powering off and rebooting the phone to prevent access to the terminal.

Further, this portion of Vaihoja is step 10 of a local programming process that starts with a user entering information using "the phone's keyboard".

As stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). As confirmed in MPEP § 2145, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983). Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not have combined these references as the operation suggested by the Examiner is taught away from in the Vaihoja and rebooting is not useful for the UIM locking feature of Meche.

Further, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the systems of Meche and Vaihoja to arrive at Applicant's claimed combinations absent impermissible hindsight reference to Applicant's specification. Withdrawal of the rejection of claims 1-2, 10-13 and 15-17 under 35 U.S.C. § 102 and claims 3-8 and 16 under 35 U.S.C. § 103 is respectfully requested.

Newly Added Claims

Claims 20-25 are newly added by this Amendment and believed to be in condition for allowance.

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CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Carl R. Wesolowski**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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